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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,196	12/21/2001	Thomas A. Love	000105-0001	8436

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EXAMINER

THOMPSON, CAMIE S

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 01/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/026,196

Examiner

Camie S Thompson

Applicant(s)

LOVE, THOMAS A.

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONEO (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22, 24-27 and 32-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22, 24-27 and 32-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Applicant's amendment and accompanying remarks filed November 6, 2003 have been acknowledged.
2. Examiner acknowledges amended claims 1, 4, 10, 15 and 32-33.
3. Examiner acknowledges the amendment to specification in regards to the priority information. Therefore, the objection to the priority and the oath/declaration is withdrawn.
4. The objection to claim 15 is withdrawn due to applicant's amended claim 15.
5. The rejection of claims 10-22 and 32-33 under 35 U.S.C. 102(b) as being anticipated by Vandermeer, U.S. Patent Number 5,945,049 is withdrawn due to applicant's argument.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-22, 24-27 and 32-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Shannon, U.S. Patent Number 3,661,663.

Shannon discloses an insulation material used as a pressed fiberboard wherein the fibrous material includes alumina silicate fibers and mineral wool and the fiber content is greater than any other solid ingredient in the fiberboard as per instant claims 1, 10 and 32 (see Example 13, column 5, line 65- column 6, line 8 and Example 7). The reference also discloses that the fibers

can be grouped together as per instant claims 10 and 12 (see column 1, lines 39-40). Although Example 13 of the reference discloses using organic binders, the reference discloses a preferred embodiment of using inorganic binders. Shannon also discloses that the body of fibers is bonded together with potassium silicate as per instant claims 10-11 and 13-15 (see column 1, lines 25-65). In addition, Shannon discloses using bentonite clay as filler material as per instant claims 16-17 (see column 2, lines 46-75). Examples 6 and 8 of the Shannon reference disclose that the fiber weight of the fiberboard is about 75%, 7% sodium silicate binder and about 15% magnesium silicate filler as per instant claims 18-22 and 32. The process limitation of providing fiberation, forming a mat, accumulating layers, heating, pressing and drying and the additional of further material are not given any patentable weight in a product claim. Claims 1-9 and 23-27 are product-by-process claims. Even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process. See MPEP 2113.

Response to Arguments

8. Applicant's arguments filed November 6, 2003 have been fully considered but they are not persuasive. Applicant argues the method of the Shannon reference versus the method of the instant application. The instant claims are drawn to the rigid fiberboard. The Shannon reference recites an insulation material used as a pressed fiberboard wherein the fibrous material includes

alumina silicate fibers and mineral wool and the fiber content is greater than any other solid ingredient in the fiberboard as does the instant application. Additionally, the Shannon reference discloses the preferred use of inorganic binders, as does applicant. Applicant argues that the Shannon reference use inorganic binder after the use of organic binder. The Shannon reference discloses that the clay silica binder can be used to form the high temperature insulation under the same conditions that an organic binder can be used. For clarification, it is disclosed in column 1, lines 35-63 of the Shannon reference that the lightweight insulation is made by forming a skeleton of siliceous fibers wherein the fibers are grouped together. Shannon discloses the skeleton as fibers not fibers with an organic binder as argued by applicant. Both the Shannon reference and the instant application are drawn to an insulation material used as a pressed fiberboard. Therefore, they are the same product regardless of the manner in which they were processed.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communication from the examiner should be directed to Camie S. Thompson whose telephone number is (571) 272-1530. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly, can be reached at (571) 272-1526. The fax phone numbers for the Group is (703) 872-9306.

A handwritten signature in cursive script, appearing to read "Cynthia H. Kelly". The signature is written in dark ink and is located in the lower right quadrant of the page.